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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,834	12/08/2000	Neil A. Willcocks	02280.002680.	1867
5514 7590 11/02/2009 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER ALVAREZ, RAQUEL				
ART UNIT 3688		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/731,834

**Applicant(s)**

WILLCOCKS ET AL.

**Examiner**

Raquel Alvarez

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-10, 12-27, 29, 30, 32 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10, 12-27, 29, 30, 32 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to communication filed on 7/6/2009.
2. Claims 1-2, 4-10, 12-27, 29-30, 32 and 36-40 is presented for examination.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-10, 12, 14-19, 21-27, 29-30, 32 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell (2001/0042010 hereinafter Hassell).

With respect to claims 1-2, 4, 6-10, 14-19, 21, 23-27, 29-30, 32, 36-40, Hassell teaches a method for motivating a consumer to make a purchase a product and/or service electronically over a computer network upon viewing an offer for sale of said product and/or service on a Web site (Figure 2A). Providing from a server over the computer network to a consumer's computer a program that causes said computer to

(a) display on a Web site an offer for sale of a product and/or service that may be purchased from said vendor by said consumer via the computer web site (Figure 2A);

(b) display on said web site an incentive for purchasing said product and/or service wherein said incentive is displayed while said consumer is visiting said web site, and wherein said program causes said incentive to be initially set to an initial value and then changes said incentive over a period of time to other displayed values while the consumer is visiting said website (paragraph 0059);

( c ) when said consumer makes an electronic purchase of said of said product and/or service by electronically accepting said offer, provide to said server an indication of acceptance and a current displayed value of said incentive (paragraph 0033);

registering at the server an initial time at which said incentive is initially displayed (i.e. registering the day date and/ or time the coupon was clicked)(paragraph 25);

registering at said server an acceptance time at which said consumer electronically accepts said offer (i.e. tracking when the coupon is redeemed)(paragraphs 0033 0058 and 0059) ; and

comparing said initial time and said acceptance time to verify the provided current displayed value of said incentive and wherein said incentive is electronically redeemed for said verified current displayed value (i.e. based on the time that has lapsed from where the coupon was clicked it determines the value of the coupon's redemption value )(paragraph 0059).

With respect to displaying the offer on a web page of a vendor that offer the product for sale. Hassell teaches displaying the offer at a third party service provider. Hassell doesn't specifically teach displaying the offer at the vendor's website. Official Notice is taken that it is old and well known for consumers/users to directly log on to vendor's websites in order to receive coupons and redeem the coupons at the same site in order facilitate and save time. For example New York and company ®, Lord and Taylor ®, Nordstrom ® ,Macy's ® and the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included directly

logging on to the vendor's site to clip on coupons and to redeem the coupons in order to obtain the above mentioned advantage.

With respect to claim 5, Hassell further teaches that the incentive is presented via a web banner (paragraph 0021).

With respect to claims 12 and 22 Hassell further teaches wherein a consumer who frequently uses said incentive for purchasing products and/or services is accorded a more favorable incentive than a consumer who infrequently uses said incentive to purchase goods and/or services (i.e. customer are rewarded for purchases. Customer who make more purchases receive reward and consumers who don't make purchases don't receive rewards)(paragraph 0059).

5. Claims 13 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell in view of Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claim 13, Barnett further teaches wherein said frequent consumer is accorded a higher maximum incentive value (col. 13, lines 30-42). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Hassell, the teachings of Barnett of said frequent consumer is accorded a higher maximum incentive value in order to motivate and compensate the best customers.

With respect to claim 20, Barnett further teaches wherein said information relates to a location of said consumer (see claims 5 and 31 Of Barnett). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Hassell, the teachings of Barnett of relating the profile to consumer's location because such a motivation would allow to target local offers/vendors to the consumers.

### **Response to Arguments**

6. Applicant argues that here is no suggestion whatsoever in *Hassell* that the Web page content 30 is part of a vendor's Web site, nor is there any suggestion that the Web page content 30 displays an offer for sale of a product and/or service that may be purchased from a vendor via the Web page content 30. Applicant is reminded that the claims were rejected under the doctrine of 103 and should be argued accordingly. The examiner has taken official notice that displaying the offer/coupon on the vendor's website where the product may be purchased is old and well known and Applicant hasn't properly challenged Examiner's assumption. In addition, Hassell teaches on paragraph 0069 an additional embodiment where the user can request coupons directly from merchants/vendors website.

7. Applicant argues that Hassell clippable coupon is not an offer for sale of an item but instead merely is an advertisement for the item. Additionally, the act of selecting or clipping a clippable coupon (for example, by "clicking" on it) does not result in a purchase but instead causes the coupon to be stored in a folio, as discussed above. In

fact, Hassell specifically teaches away from the coupon causing any direct purchasing action. The Examiner disagrees with Applicant because Hassell teaches an additional embodiment including clicking on the clippable coupon takes the user to a specified site in order for the user to redeem the coupon (see paragraphs 0019 and 0071).

Therefore, contrary to Applicant's arguments, Hassell doesn't teach away from causing direct purchasing action, because as can be seen by Hassell above, the user can click on the clippable coupon and it takes the customer directly to the specified web site where the coupon can be redeem.

8. Applicant argues that Hassell doesn't teach or suggest the features of: "registering at said server an initial time at which said incentive is initially displayed; registering at said server an acceptance time at which said consumer electronically accepts said offer; and comparing said initial time and said acceptance time to verify said provided current displayed value of said incentive, wherein said incentive is electronically redeemed for said verified current displayed value," The examiner disagrees with Applicant because Hassell teaches on paragraph 0025 registering the day date and/ or time the coupon was clicked, tracking when the coupon is redeemed on paragraphs 0033 0058 and 0059; and based on the time that has lapsed from where the coupon was clicked it determines the value of the coupon's redemption value paragraph 0059.

9. Applicant states on page 20 of "Remarks" that The *Hassell* system ensures that a consumer does not lose the opportunity provided by the coupon, because the clipped coupon is stored in the consumer's personal folio. As such the consumer

need not act on the coupon with any urgency. In contrast, as explained above, the claims of the present application are aimed at enticing a curious consumer (*i.e.*, a consumer who is interested in a vendor's products and/or services) to make an impulse purchase from the vendor while on or visiting the vendor's Web site to obtain information about the vendor's products and/or services. As explained above, Hassell has additional embodiments including the user clicking on the clippable coupon on the merchant's website and allowing the customer to click on the coupon in order for automatically redemption of the coupon instead of storing it therefore impules the customer to make an instant purchase(paragraphs 0069 0070 and 0071)

### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

Raquel Alvarez  
Primary Examiner  
Art Unit 3688

R.A.  
10/28/2009